

Appl. No. 10/582,761
Amdt. Dated May 17, 2010
Reply to Office Action of December 15, 2009

REMARKS/ARGUMENTS

Claims 1-9 and 11 are pending. No new matter has been added to the claims.

Double Patenting

Claims 1-9 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/086,632. In response, Applicants submit that a terminal disclaimer will be filed once the instant application is indicated as allowable.

THE REJECTIONS UNDER 35 U.S.C. § 112, first paragraph

SHOULD BE WITHDRAWN

Claims 1-7 are rejected under 35 U.S.C. § 112, first paragraph, because the specification does not reasonably provide enablement for a method of labeling synthesis of any labeled compound comprising performing the steps of claim 1. Applicants respectfully disagree. Applicants submit that figure 1 within the specification clearly shows a flow chart of the method according to the invention. Figures 2 and 3 additionally depict specific views of the present invention. Applicants therefore submit that the rejection of claims 1-7 should be withdrawn for these reasons.

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THE REJECTIONS UNDER 35 U.S.C. § 103(a)

SHOULD BE WITHDRAWN

Claims 1-9 and 11 are rejected under 35 USC 103(a) as being unpatentable over Dickson in view of Kihlberg et al. and further in view of Kihlberg et al. (WO02/102711). Applicants respectfully submit that “the prior art itself must provide a motivation or reason for the worker in the art, without the benefit of the Applicant’s specification, to make necessary changes in the reference device”. See, *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438 (PTO Bd. App. 1984). The Office has used the Applicants invention to try to recreate the present invention by using Dickson. As the Examiner indicates Dickson does not specifically teach performing the reaction using 11C-labelled carbon monoxide. Dickson does not disclose, teach, or suggest the present invention. Further, neither Kihlberg (assignee is GE Healthcare as well) discloses the method in the present invention. Please see figures 1-3 in the specification.

It is therefore respectfully submitted that the 35 U.S.C. 103(a) rejections of claims 1-7, and 11 as being unpatentable over Dickson in view of Kihlberg et al. and in further view of Kihlberg (WO02/102711) be withdrawn.

CONCLUSION

In view of the remarks herein, Applicants believe that each ground for rejection or objection made in the instant application has been successfully overcome or obviated, and

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that all the pending claims are in condition for allowance. Withdrawal of the Examiner's rejections and objections, and allowance of the current application are respectfully requested.

The Examiner is invited to telephone the undersigned in order to resolve any issues that might arise and to promote the efficient examination of the current application.

Respectfully submitted,

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